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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,923	10/30/2001	Keicy K. Chung	264/031	7533
167	7590	09/12/2005	EXAMINER	
FULBRIGHT AND JAWORSKI LLP 555 S. FLOWER STREET, 41ST FLOOR LOS ANGELES, CA 90071			JAROENCHONWANIT, BUNJOB	
			ART UNIT	PAPER NUMBER

2143

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

*Supplemental*  
**Office Action Summary**

Application No.

10/017,923

Applicant(s)

CHUNG, KEICY K.

Examiner

Bunjob Jaroenchonwanit

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **SUPPLEMENTAL DETAILED ACTION**

1. In response to the request for new Office Action, because the Office Action mailed 06/16/05 inadvertently omitted rejection of newly added claims 11-15. Since, such omission is brought to the Office's attention more than two months after mailing date of the previous Office Action, the Office will set a new period for reply for **ONE MONTH** from the mailing date of this Office Action (MPEP § 710.06).
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/21/05 has been entered.
3. In response to the amendment filed 03/21/05, Claims 1-10 were amended; Claims 11-15 were added; claims 1-15 are pending for examination. Newly rejection are as stated below.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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5. Claims 1-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 2004/0243727. Although the conflicting claims are not identical, they are not patentably distinct from each other because context of claims invention are the same.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable under Yang (US 2004/0267902) and Lakritz (US 6,623,529).

8. Regarding claims 1, 4, 7, 8 and 10, Yang discloses a storage device, comprising a processor localized to a computer (processor 46, Fig. 2);

a computer interface connected to the process, wherein interface is adapted to enable communications exclusively between the computer and the processor, the processor has read write access to the storage means (Host 1 exclusively communicates with processor 46 via SCSI interface 40, Fig. 2);

a network interface communicably connected to the processor to enable the processor to communicate with a remote file server, wherein the processor is adapted to employ the network interface for communications exclusively with the remote file server (processor 46 connected to Ethernet interface to TCP/IP network, Fig. 2); and a storage means connected to the processor (storage 54 connected to processor 46, Fig. 2).

Yang expresses same system architecture for caching data from IP network to reduce unnecessary network traffic (paragraph 9) and suggests its' processor is capable of determining, upon receipt a file request, whether the file is in cache, if it is then provide it to the requestor. If the file is not in its' cache then forwards the request to a remote server in a network (paragraph 40).

Yang does not explicitly disclose type of file is read only or else and sending notification or file unavailable messages, if the file cannot be obtained from anywhere.

However, in the same field of endeavor, Lakritz discloses an analogous system for serving similar objective that is to minimize network traffic. Lakritz's teaching includes a process of determining whether a file is in cache storage, if not, requests from a remote file server and caches the file prior to send to the requestor (Fig. 3). Further, Lakritz also teaches a process of notifying client if the requested file does not exist (Fig.10, Col. 36, lines. 57-60). Furthermore, Lakritz specifically deals with caching web page, which is a type of read-only file.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made that to combine teaching of Lakritz's processes with Yang's invention, to improve efficiency and responsive to users' requests in order to minimize network traffic in Internet networking.

9. Regarding claims 11 and 14, Yang-Lakritz discloses the invention substantially, as claimed, as described in claim 1 above, including a capability of making determination whether a requested file is available. Even though, it does not express determining availability of particular file type such as boot file but it would have been obvious to one of ordinary skilled in the art at the time of applicant's invention was made to recognize that was merely a matter of choice of

Art Unit: 2143

implementation, which clearly does not require any inventive step, since determination process is accomplished by assigning file name, extension or the like, as determination parameter. Hence changing type of file is obvious and is not patentable distinct form Yang-Lakritz.

10. Claims 2, 5 and 12, Yang-Lakritz discloses does not explicitly disclose the host includes network interface. Official Notice is taken (see MPEP 2144.03) network interface was notoriously well known in the art at the time of the invention was made. Nearly most of the computer sold at the time of applicant's invention was made, readily equipped with network interface, to allow user to connect to Internet. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to include network interface with a computer, if it has not done so, because it would expand computer's utility and be attractive to buyers..

11. Claims 3, 6 and 13, Yang-Lakritz discloses random access media (Yang, Fig. 2, RAM 48).

12. Claim 9, Yang-Lakritz discloses deleting cache content (Yang, paragraph 37).

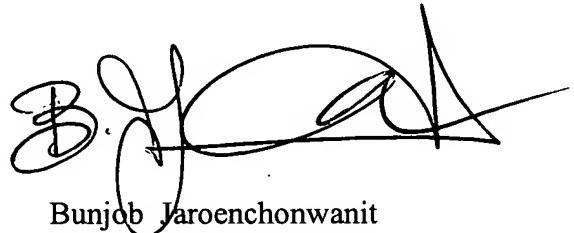
13. Claim 15, Yang-Lakritz discloses a computer communicates to a network server through a storage device (Yang Fig.2, host 1 communicates with IP network through storage device 12).

14. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bunjob Jaroenchonwanit whose telephone number is (571) 272-3913. The examiner can normally be reached on 8:00-17:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (571)

Art Unit: 2143

272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'B. Jaroenchonwanit', with a long horizontal stroke extending to the right.

Bunjob Jaroenchonwanit  
Primary Examiner  
Art Unit 2143

/bj  
9/2/05